

REMARKS/ARGUMENTS

Election

Applicants herein elect, with traverse, Group I (claims 1 and 2) and SEQ ID NO:4 for prosecution on the merits.

Applicants respectfully disagree with, and traverse the Sequence Election Requirement.

Applicants intend that SEQ ID NOS:1-5 be presented and interpreted as a Markush-type grouping of amino acid sequences which share a common utility (all are predictive of Type II diabetes). Markush-type claims are defined as a grouping including a plurality of alternatively usable substances or members (MPEP 803.02). At page 46, lines 6-16, SEQ ID NOS:1-5 are disclosed as a group of disease specific markers predictive of Type II diabetes. Thus, the entire group (SEQ ID NOS:1-5), selected members or any one of SEQ ID NOS:1-5 can be used as disease specific markers predictive of Type II diabetes.

In contrast to Applicants presentation of SEQ ID NOS:1-5 in a Markush-type grouping, the Sequence Election Requirement presents each of SEQ ID NOS:1-5 as unrelated, patentably distinct sequences, thus introducing a contradiction into the prosecution history. Such contradictions can potentially diminish the value of any patent that may issue from the instant application.

Now that it has been shown that SEQ ID NOS:1-5 share a common utility (predictive of Type II diabetes), Applicants respectfully

request that the Examiner re-consider the Sequence Election Requirement.

Claim Status/Support for Amendments

Claim 1 has been amended. Claims 2-38 have been cancelled. New claims 39-46 have been added. Claims 1 and 39-46 remain pending in the instant application.

No new matter has been added by the amendments to claim 1. Claim 1 has been amended to recite only elected SEQ ID NO:4 and to incorporate the subject matter of cancelled claim 2. Claim 1 has also been amended to clarify that the claimed peptide (SEQ ID NO:4) has been isolated from its naturally occurring state; see page 20, lines 9-16 of the instant specification for support.

No new matter has been added by the addition of new claims 39-46. The subject matter of new claims 39-46 corresponds with subject matter originally found in cancelled claims 2-38. The above additions to the claims also find basis in the original disclosure at page 25, line 16 to page 26, line 22. The method of new claim 39 is described in detail at pages 37-47. Page 48, lines 2-6 refers to use of various types of samples and page 38, line 22 to page 39, line 12 refers to different mass spectrometric techniques. Page 47, line 2 refers to practicing the claimed methods with a human patient. Pages 47-48 describe kits contemplated for use with the claimed methods. Page 47, line 20 to page 48, line 2 refers

particularly to the immobilizing on solid supports and labeling of components of the contemplated kits. It is clear from these specific recitations and from the description of methods utilized that the methods and types of kits recited in the newly added claims (39-46) were fully contemplated by the inventors at the time of filing and were enabled by virtue of the disclosure as originally filed.

CONCLUSION

Now that Applicants have fully responded to the Office Action mailed on October 6, 2004, an examination on the merits is respectfully requested.

Respectfully submitted,

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